

Restriction has been required between the inventions, as identified by the Examiner, of Groups I (method of manufacture), Group II (a mold used in manufacture) and Group III (an outsole of a shoe). A provisional election of the invention of Group III, with traverse, has been made, above. Election of species has also been required within the elected invention of Group III, between (twenty-two) species A - V. A provisional election of species L (Figure 22) has also been made, with traverse, above. (Election of species was also required between Species I - III of Group II, if elected.) Claims 5 - 7, 10 and 11 have been designated as readable on the elected species. The Examiner has identified Claim 5 as being generic and it is respectfully submitted that claims 7 and 10 are generic, as well, by being drawn to perfecting features of the invention which may be included in or omitted from any identified species, including the elected species and, as will be discussed in greater detail below, do not represent independent species *per se* as asserted by the Examiner. Further, claims 6 and 11, which are clearly readable on the elected species, are considered to be generic to the species of Figures 10 - 13, 19 - 20 and 22 - 25 or *substantially half of the species identified by the Examiner*.

It is respectfully submitted that the requirements for restriction and election of species are unwarranted, excessive and unsupported by either distinctness of inventions or independence of species or a serious burden of examination in the absence of either or both requirements. It is respectfully pointed out that the Examiner has identified three inventions and twenty-five species among eleven claims and, within the elected invention of Group III, the Examiner has identified twenty-two species among the seven claims of Group III. The Examiner has not made any demonstration of distinctness of inventions or

independence of species beyond the assertion of separate classification and an assertion that the claims lack unity of invention under PCT Rule 13.1 since they are not directed to the same or corresponding technical feature. On the contrary, the method of claim 1, the molds of claims 2 - 4 and the outsoles which can be formed are all directed to the provision of throughout holes in a midsole for a shoe and the method and the molds are both directed to facilitating production of throughout holes of a desired shape and properties in a molded midsole.

Therefore, it is respectfully submitted that the inventions recited in the claims of Groups I - III do, indeed present "corresponding special technical features", contrary to the assertion by the Examiner.

It is also respectfully submitted that a requirement for restriction, even if based on PCT Rules, must comply with policies of the USPTO which require a *demonstration of both* independence of species or distinctness of inventions and the existence of a serious burden of examination in the absence of the requirement made. As pointed out above, no such demonstration of either independence/distinctness or serious burden has been made by the Examiner and the Examiner has thus failed to make a *prima facie* demonstration of the propriety of either requirement. As to serious burden, it is also respectfully pointed out that in failing to demonstrate distinctness, the Examiner has failed to demonstrate the general utility of the method or the mold, as claimed, to form objects other than parts of a shoe and thus does not demonstrate the propriety of the proposed classification of Group II in Class 425, as asserted. Moreover, while it is not known to be currently the case, Class 12 and Class 36 have been traditionally examined in the same Group Art Unit; tending to indicate commonality of search and subject matter

rather than having acquired a separate status in the art. The Examiner has not indicated any divergence of search or and search area required for any identified invention (or species) where no relevant prior art would be expected in regard to any other identified invention (or species). Further, the requirement for restriction, even if proper, would only result in four claims being withdrawn from consideration and the requirement for election of species, even if proper, results in only two claims being withdrawn from consideration. It is well-established that when an action can be given on all claims without a serious burden, neither restriction nor election of species should be required.

Additionally, it is respectfully submitted that the requirement for election of species contains substantive errors. As pointed out above, claims 6 and 11 which are most specific to the embodiment illustrated in Figure 22 (provisionally elected species L) by referring to a "vertical support" or "erect protrusions" are also readable on the species of Figures 10 - 13, 19 - 20 and 22 - 25 which also include structures in the throughout holes which protrude in the vertical direction and provide support in the vertical direction and the embodiments of the invention illustrated therein are thus not, in fact, independently claimed species. That is, it is respectfully submitted to be improper to identify species which are generically claimed. Moreover, as alluded to above, it is respectfully submitted that perfecting features such as plugs or covers for the throughout holes, cushion fillers, air bags or support tubes, any or all of which may or may not be installed in throughout holes of any form, or elastic bars or plates which are not related to the throughout holes or anything that may or may not be installed therein, which are usable with all other identified species are

not *independent* or mutually exclusive and thus not properly identifiable as separate species. The Examiner has, in fact, effectively acknowledged that such perfecting features do not represent separate species by indicating that Figure 16, illustrating covers or plugs for the throughout holes, is included with the embodiment of Figure 15 as species F. It is respectfully submitted that other disclosed features such as fillers, tubes and/or elastic bars or plates which may or may not be employed with any embodiment of the invention and each other are, similarly, not mutually exclusive or independent and thus not properly identifiable as separate species.

In summary, it is respectfully submitted that the requirement for restriction is unwarranted and unsupported by either distinctness of identified inventions or a serious burden in the absence of such a requirement and the requirement for election of species is largely illusory and unwarranted. Further, the small number of claims which would be withdrawn from consideration under the election made strongly indicates that no serious burden of examination can exist and that an action should be given on all claims in the application and that the requirements and the requirement for election of species, in particular, are excessive and prejudicial. Accordingly, it is respectfully submitted that the requirements are improper and in error and reconsideration and withdrawal of the same is respectfully requested.

Since all requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in

condition for allowance and such action is therefore respectfully requested.

A petition for a five-month extension of time has been made above. If any extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



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